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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/088,034	08/26/2002	Timothy Winston Hibberd	A-71400 DJB/VEJ	6572
32940 7590 01/30/2007 DORSEY & WHITNEY LLP 555 CALIFORNIA STREET, SUITE 1000 SUITE 1000 SAN FRANCISCO, CA 94104			EXAMINER NOBAHAR, ABDULHAKIM	
			ART UNIT	PAPER NUMBER
			2132	
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		01/30/2007	PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No. 10/088,034	Applicant(s) HIBBERD, TIMOTHY WINSTON	
	Examiner Abdulhakim Nobahar	Art Unit 2132	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 September 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8, 14 and 16-18 is/are rejected.
- 7) ☒ Claim(s) 9-13, 15 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

'DTAILED ACTION

1. This communication is in response to applicants' response received on September 28, 2006.
2. Claims 1-18 are pending.
3. Applicant's arguments with respect to the rejections of claims 1-18 under 35 USC § 102 have been fully considered and are persuasive. Therefore, the rejections have been withdrawn. However, upon further consideration of the amended claims, a new ground(s) of rejection is made.
4. When responding to the Office action, Applicant is advised to clearly point out the patentable novelty the claims present in view of the state of the art disclosed by the reference(s) cited or the objection made. A showing of how the amendments avoid such references or objections must also be present. See 37 C.F.R. 1.111(c).

Specification

The following guidelines illustrate the preferred layout for the specification of a utility application. These guidelines are suggested for the applicant's use.

Arrangement of the Specification

As provided in 37 CFR 1.77(b), the specification of a utility application should include the following sections in order. Each of the lettered items should appear in upper case, without underlining or bold type, as a section heading. If no text follows the section heading, the phrase "Not Applicable" should follow the section heading:

- (a) TITLE OF THE INVENTION. (Provided)
- (b) CROSS-REFERENCE TO RELATED APPLICATIONS. (Not provided)

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- (c) STATEMENT REGARDING FEDERALLY SPONSORED RESEARCH OR DEVELOPMENT. (Not applicable, if any)
- (d) THE NAMES OF THE PARTIES TO A JOINT RESEARCH AGREEMENT. (Not provided, if any)
- (e) INCORPORATION-BY-REFERENCE OF MATERIAL SUBMITTED ON A COMPACT DISC. (Not applicable)
- (f) BACKGROUND OF THE INVENTION.
 - (1) Field of the Invention. (Not provided)
 - (2) Description of Related Art including information disclosed under 37 CFR 1.97 and 1.98. (Not provided)
- (g) BRIEF SUMMARY OF THE INVENTION. (Not provided)
- (h) BRIEF DESCRIPTION OF THE SEVERAL VIEWS OF THE DRAWING(S). (Not provided)
- (i) DETAILED DESCRIPTION OF THE INVENTION. (Title not provided)
- (j) CLAIM OR CLAIMS (commencing on a separate sheet). (Provided)
- (k) ABSTRACT OF THE DISCLOSURE (commencing on a separate sheet). (Provided)

Content of Specification

- (a) Title of the Invention: See 37 CFR 1.72(a) and MPEP § 606. The title of the invention should be placed at the top of the first page of the specification unless the title is provided in an application data sheet. The title of the invention should be brief but technically accurate and descriptive, preferably from two to seven words may not contain more than 500 characters.
- (b) Cross-References to Related Applications: See 37 CFR 1.78 and MPEP § 201.11.
- (c) Statement Regarding Federally Sponsored Research and Development: See MPEP § 310.
- (d) The Names Of The Parties To A Joint Research Agreement: See 37 CFR 1.71(g).
- (e) Incorporation-By-Reference Of Material Submitted On a Compact Disc: The specification is required to include an incorporation-by-reference of electronic documents that are to become part of the permanent United States Patent and Trademark Office records in the file of a patent application. See 37 CFR 1.52(e) and MPEP § 608.05. Computer program listings (37 CFR 1.96(c)), "Sequence Listings" (37 CFR 1.821(c)),

and tables having more than 50 pages of text were permitted as electronic documents on compact discs beginning on September 8, 2000.

- (f) Background of the Invention: See MPEP § 608.01(c). The specification should set forth the Background of the Invention in two parts:
- (1) Field of the Invention: A statement of the field of art to which the invention pertains. This statement may include a paraphrasing of the applicable U.S. patent classification definitions of the subject matter of the claimed invention. This item may also be titled "Technical Field."
 - (2) Description of the Related Art including information disclosed under 37 CFR 1.97 and 37 CFR 1.98: A description of the related art known to the applicant and including, if applicable, references to specific related art and problems involved in the prior art which are solved by the applicant's invention. This item may also be titled "Background Art."
- (g) Brief Summary of the Invention: See MPEP § 608.01(d). A brief summary or general statement of the invention as set forth in 37 CFR 1.73. The summary is separate and distinct from the abstract and is directed toward the invention rather than the disclosure as a whole. The summary may point out the advantages of the invention or how it solves problems previously existent in the prior art (and preferably indicated in the Background of the Invention). In chemical cases it should point out in general terms the utility of the invention. If possible, the nature and gist of the invention or the inventive concept should be set forth. Objects of the invention should be treated briefly and only to the extent that they contribute to an understanding of the invention.
- (h) Brief Description of the Several Views of the Drawing(s): See MPEP § 608.01(f). A reference to and brief description of the drawing(s) as set forth in 37 CFR 1.74.
- (i) Detailed Description of the Invention: See MPEP § 608.01(g). A description of the preferred embodiment(s) of the invention as required in 37 CFR 1.71. The description should be as short and specific as is necessary to describe the invention adequately and accurately. Where elements or groups of elements, compounds, and processes, which are conventional and generally widely known in the field of the invention described and their exact nature or type is not necessary for an understanding and use of the invention by a person skilled in the art, they should not be described in detail. However, where particularly complicated subject matter is involved or where the elements,

compounds, or processes may not be commonly or widely known in the field, the specification should refer to another patent or readily available publication which adequately describes the subject matter.

- (I) Sequence Listing. See 37 CFR 1.821-1.825 and MPEP §§ 2421-2431. The requirement for a sequence listing applies to all sequences disclosed in a given application, whether the sequences are claimed or not. See MPEP § 2421.02.

The incorporation of essential material in the specification by reference to an unpublished U.S. application, foreign application or patent, or to a publication is improper. Applicant is required to amend the disclosure to include the material incorporated by reference, if the material is relied upon to overcome any objection, rejection, or other requirement imposed by the Office. The amendment must be accompanied by a statement executed by the applicant, or a practitioner representing the applicant, stating that the material being inserted is the material previously incorporated by reference and that the amendment contains no new matter. 37 CFR 1.57(f).

Drawings

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. The provided Figure 1 is a general drawing that depicts a general communication or a computer system. None of the limitations of the claims are shown in this drawing. Therefore, at least the main features of claims 1-18 such as "sending unique identification data to said apparatus in response to said initial access request", "a second control level applying hack program

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detection tests to said access requests and verifying said user", "invoking sequentially the levels of access control depending on the number of failed attempts to verify said identification data by said user for access requests over predetermined periods of time" and so on must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Objections

Claim 18 is objected to because of the following informalities:

This claim, in line 6, recites "...and providing the data received..." which does not specify the data. Examiner suggests that the claim should be amended to recite "...and providing the identification data received..."

This claim contains "IVR" abbreviation in line 5. The abbreviated words should be included in the claim.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

Claims 1, 5, 14 and 18 are rejected under 35 U.S.C. 112, **second paragraph**, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 includes limitation for receiving an access request for a service from a processing apparatus, sending a unique identification data to the processing apparatus and applying a rate limit for verifying access to said service. Claim 1 does not provide any action step prior to the step of applying a rate limit to specify what is happening after the second action step. Since it is not provided that what actions are executed after sending a unique identification data to the processing apparatus, the "applying a rate limit ..." becomes unclear and meaningless. Examiner suggests that the claim should include steps prior to the last step such as sending a data to the server by the apparatus and verifying or checking the received data from the apparatus by the server

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that whether it corresponds to the sent unique identification data as described in the specification.

The same is applied to the **claims 14 and 18**.

Claim 1, in lines 5 and 6, recites "...until said identification data is verified by a user of said apparatus" and **claim 5**, in line 1 and 2, recites "said identification data is verified by said user." These recitations are contrary to the verification procedure described in the specification (see page 4, line 20 through page 5, line 5 and page 5, lines 19-31). According to the verification procedure, the access control system sends an identification data to the user after receiving an access request from the user. The user responds to the access control system by sending an identification data. If the sent and received identification data by the access control system correspond to each other then the user is verified and is allowed to access resources on the application server. Thus, the identification data is verified by the access control system not by the user. Examiner suggests that the claim should be amended to recite, for example, "applying a rate limit for allowing a user of said apparatus to access said service until an access control server verifies said identification data received from the user of said apparatus."

Claim 1, in line 5, recites "applying a rate limit for verifying access..." **claim 14**, in line 2, recites "applying an access rate limit ..." and **claim 18**, in line 3, recites "rate limit access to the server..." These claims neither specify the object of the applied rate limit nor the nature of the rate limit (i.e., what the rate limit really is).

The above observations make the claims 1, 5, 14 and 18 indefinite.

Appropriate corrections are required.

Claim 14 is rejected because the method steps are recited in a narrative fashion and are outlined without providing any real action performed to allow a user to access a requested service or locking a user out due to a certain number of failed attempts. For example, it is not provided how a user or a request is verified, how a hack program is applied, how a predetermined download software can be used for verifying a user and why an access should be blocked based on a communication address. If the communication address proved to be used by a hacker then the claim should specify that reason.

The following is a quotation of the **first paragraph** of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 1 is rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling. The response of the user by sending an identification data to the server to be verified after receiving from the server a unique identification data is essential to the practice of the invention, but not included in the claim. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976). Sending an identification data to the server by the user and verification of this data by the server whether it corresponds to the unique identification data sent to the user apparatus are essential

steps to the invention because that is the only option described in the specification which is used to verify a user and allowing the user to access a service on a server (see specification page 5, lines 19-31).

Claims 14 and 18 are rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling. The use of an identification data transmitted between a server and user in order to verify the user by the server is essential to the practice of the invention, but not included in the claims. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976). Sending an identification data to the server by the user after receiving from the server a unique identification data and verification of the received data by the server whether it corresponds to the unique identification data sent to the user apparatus is essential to the invention because that is the only information is used to verify a user and allowing the user to access a service in the claimed invention described in the specification (see specification page 5, lines 19-31).

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 1 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

This claim recites "applying a rate limit for verifying access to said service until said identification data is verified by a user of said apparatus" which does not specify whether after the verification of the identification data the user is granted access to the requested service or not (i.e., the result is not known). Furthermore, due to lack of sufficient action steps in this claim as stated above under ***Claim Rejections - 35 USC § 112***, it is not clear whether a tangible result is attainable. Thus, the claimed invention in this claim does not fulfill the requirements of 35 U.S.C. 101 and is non-statutory.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-8, 16 and 17 are rejected under 35 U.S.C. 102(e) as being anticipated by Guthrie et al (6,161,185; hereinafter Guthrie).

As per claims 1, 16 and 17, Guthrie discloses an access control method (see Fig. 4), including:

receiving an initial access request for a service from a data processing apparatus (see col. 4, lines 18-19; col. 7, lines 17-19, where transmitting the user

account and account password by the client apparatus to the server corresponds to the recited initial access request);

sending unique identification data to said apparatus in response to said initial access request (col. 4, lines 18-19; col. 7, lines 20-26, where the server transmit a challenge having a certain length to the client that corresponds to the recited sending unique identification data to said apparatus); and

applying a rate limit for verifying access to said service until said identification data is verified by a user of said apparatus (see col. 4, lines 29-35; col. 8, lines 7-40, where the set of failures that determine whether a client should be locked out after certain number of authentication failures corresponds to the recited applying a rate limit).

As per claim 2, Guthrie discloses an access control method as claimed in claim 1, wherein verifying said identification data corresponds to a first level of access control, and said method includes applying at least one additional level of access control following a predetermined number of failed attempts to verify said identification data by said user of said apparatus (see col. 4, lines 1-13).

As per claim 3, Guthrie discloses an access control method is claimed in claim 2, wherein said identification data is a random unique security code (see col. 4, lines 16-18, where the seed value corresponds to the recited random unique security code; col. 6, lines 57-60) and said apparatus is sent an unique

identification number which expires if the security code is not verified within a predetermined period of time (see, e.g., col. 4, lines 35-41).

As per claim 4, Guthrie discloses an access control method as claimed in claim 1, wherein said identification data is verified by contacting a device with a known association to said user and said data processing apparatus, and having said user provide said identification data using said device (Figs. 4 & 5, col. 7, lines 10-26).

As per claim 5, Guthrie discloses an access control method as claimed in claim 1, wherein said identification data is verified by said user returning said identification data using communication means having a known association to said user and said data processing apparatus (Figs. 4 & 5, col. 7, lines 10-26, where the user the user 114 is associated with the client apparatus 102).

As per claim 6, Guthrie discloses an access control method as claimed in claim 2, wherein said at least one additional level includes detecting generation of access requests for said service under control of a program instead of under control of said user (see, e.g., col. 1, lines 30-38; col. 4, lines 30-35, where using a random code generator by a user corresponds to the recited access requests for said service under control of a program).

As per claim 7, Guthrie discloses an access control method as claimed in claim 2, wherein said at least one additional level of access control includes sending

communication software to said apparatus to receive access requests for said service under an additional communication protocol (see, e.g., col. 5, lines 10-15; col. 5, lines 49-54).

As per claim 8, Guthrie discloses an access control method as claimed in claim 7, wherein said communication software encrypts said access requests (col. 3, lines 10-12).

Allowable Subject Matter

Claims 9-13, and 15 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 14-18 would be allowable if rewritten or amended to overcome the rejections under 35 U.S.C. 112, 1st and 2nd paragraphs, set forth in this Office action.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

US Patent No. 5724423 A to Khello.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Abdulhakim Nobahar whose telephone number is 571-272-3808. The examiner can normally be reached on M-T 8-6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gilberto Barron can be reached on 571-272-3799. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Abdulhakim Nobahar
Examiner
Art Unit 2132 *A.N.*

January 24, 2007

Gilberto Barron Jr.
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